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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,560	12/11/2003	Yukio Heki	AA554C	8765
27752 7590 07/31/2007 THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION - WEST BLDG. WINTON HILL BUSINESS CENTER - BOX 412 6250 CENTER HILL AVENUE CINCINNATI, OH 45224			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,560	<b>Applicant(s)</b> HEKI ET AL.	
	<b>Examiner</b> Igor N. Borissov	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/25/2007 has been entered.

### ***Response to Amendment***

Amendment received on 5/25/2007 is acknowledged and entered. Claims 3 and 11-16 have been withdrawn. Claim 4 has been canceled. Claim 1 has been amended. Claims 1-3 and 5-16 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-9 indicate that they depend on claim 4, which is canceled. Therefore, claims 5-9 are confusing.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 5-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

**(a) “Useful”** – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

**(b) “Tangible”** – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure

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became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “**Concrete**” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Traditional process can be understood as either transforming subject matter or implemented by one of the other three categories. See *Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) (“where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes.”); see also *AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 (“any step-by-step process, be it electronic, chemical, or mechanical, involves an ‘algorithm’ in the broad sense of the term.”).

Method claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. However, “...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter.” See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459.

Furthermore, the claim does not provide any indication who or what is

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performing the steps of: "indicating a question"; "selecting at least one article" and "recommending at least one article". Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than its practical implementation.

So as the claim 1 is directed to the abstract idea itself, does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*. As such, claim 1 falls outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

The remaining dependent claims do not cure § 101 deficiencies. Accordingly, Claims 1, 2, 5-10 are rejected to as being directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, and 5-10 rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over Hisanaka et al. (US 2002/0096182) in view of Teagarden et al. (US 6,014,631) and further in view of Snitkin (US 2003/0046111).**

Claim 1. Hisanaka et al. (Hisanaka) teaches a method of selection absorbent article based on information received about incontinence person, wherein said information is provided by a care person, and wherein said selecting of the absorbent articles such as disposable diapers and sanitary napkins is conducted to conform to the user's physiological and psychological requirements [0007]; [0011].

Hisanaka does not specifically teach that said received information includes information about incontinence devices which are currently used by the person. Also, Hisanaka does not specifically teach that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection.

Teagarden et al. (Teagarden) teaches a method of recommending a medication product to be used by a person for improving health condition of the person, wherein a new medication product is prescribed to a person based, at least in part, on information regarding medication product currently used by the person (C. 8, L. 42-50; C. 10, L. 60-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka to include that said received information includes information about product currently used by the person, as disclosed in Teagarden, because it would advantageously allow to design appropriate patient care through collection of appropriate information on a patient's use of medical products, and patient's satisfaction, as indicated in Teagarden (C. 6, L. 50-53).

Snitkin teaches a method for treating pelvic floor disorders, wherein in order to evaluate and improve the quality of health care, a plurality of questions with a plurality of possible answers for selection for each questions are provided to obtain information regarding urinary incontinence (Fig. 3d).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka in view of Teagarden to include that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection, as disclosed in Snitkin, because it would dvantageously allow to improve the quality of health care, as specifically stated in Snitkin [0013].

Claims 2 and 10. The method steps disclosed in Hisanaka, Teagarden and Snitkin would be performed regardless how many articles are selected, and what type of articles is selected. The motivation to modify references would be to expand line of medical product offered to customers for accommodating various medical conditions of patients.

Claims 5-9, see reasoning applied to claim 4. Information as to the specific content of the questions cannot change the method steps performed as disclosed in Hisanaka in view of Teagarden and further in view of Snitkin. Therefore, said information is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

MPEP 2106 (11) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

### ***Response to Arguments***

Applicant's arguments filed 5/25/2007 have been fully considered but they are not persuasive.

In response to the applicant's argument that Claim Rejection under 35 U.S.C. § 101 should be withdrawn, it is noted, that claims 1, 2 and 5-10 do not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claims do not require any machine or apparatus to perform the recited steps; and, finally, the claims do not provide any physical transformation of an article to a different state or thing, nor do they require any transformation of data or signals. However, "...a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter." See *In re Schrader*, 22 F.3d 295, 30 USPQ2d at 1459. Accordingly, so as the claims are directed to the abstract idea itself, do not require any machine or apparatus to perform the recited steps, and do not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim



does not represent a real world activity such as found in *Arrhythmia*, *Alappat*, or *State Street*, and, therefore, the claims fall outside the scope of § 101 as failing to apply its abstract idea to produce a useful and concrete and tangible result.

In response to the applicant's argument that Hisanaka teaches away from the use of information by a care person, it is noted that the "care person" feature upon which applicant relies in claims 1, is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the applicant's argument that Teagarden does not teach that said product is an absorbent product, it is noted that Hisanaka teaches this feature. To this end the examiner points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that \*\*\* is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Hisanaka and Teagarden relate to health care industry, wherein services are provided to a customer based on interaction with the customer.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

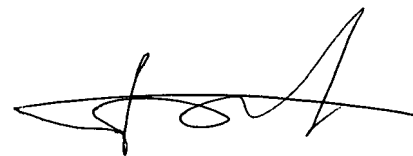
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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to recommending health-related products to a person based on person's characteristics of experience. The motivation to combine said references would be to advantageously allow to design appropriate patient care through collection of appropriate information on a patient's use of medical products, and patient's satisfaction, as indicated in Teagarden (C. 6, L. 50-53).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IGOR N. BORISSOV  
PRIMARY EXAMINER

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